

REMARKS

Upon entry of the present amendment, claims 20, 31, 33, 49, and 51 will have been canceled, while claims 53-56 will have been submitted for consideration by the Examiner. In addition, numerous of the pending claims will have been amended to either change dependency or clarify the recited features of Applicant's invention. These amendments do not narrow the scope of the claims, and accordingly, no prosecution history estoppel should attach thereto.

Initially, Applicant wishes to note an error in the previous Response filed in the present application under 37 C.F.R. § 1.116. In particular, in the amendments to the claims section of the above-noted Response, claims 31 and 44 were included. However, these claims had previously been canceled from the present application. Accordingly, the indication that these claims were "previously presented" is inaccurate. Any inconvenience caused by this error is sincerely regretted.

In the outstanding Official Action, the Examiner reconsidered the finality of the last Official Action and withdrew the same. The Examiner further withdrew the objection to claim 33. The Examiner is respectfully thanked for his actions in this regard.

Moreover, the Examiner is also thanked for his consideration and cooperation during a telephone interview conducted regarding the present application, the details of which will be set forth in more detail hereinbelow.

P17946.A14

In the outstanding Official Action, the Examiner rejected the claims in the present application under 35 U.S.C. § 103(a) as being unpatentable over OHTA (U.S. Patent No. 6,396,848) in view of MOCHIZUKI (U.S. Patent No. 6,101,526). The Examiner asserted that OHTA discloses a communication apparatus comprising the network facsimile 2, illustrated in figures 1 and 2, and a terminal apparatus, which the Examiner identified as client terminal 4A. The Examiner admitted that OHTA fails to disclose the sender data of the e-mail data, but relied upon MOCHIZUKI for this teaching.

Applicant respectfully traverses the above rejection and submits that it is inappropriate. Applicant respectfully submits that the combination of references cited by the Examiner do not teach, disclose, nor render obvious the combination of features recited in each of Applicant's claims.

By the present Response, Applicant has canceled independent claims 20 and 33. Accordingly, independent claims 30 and 43 remain pending. Additionally, independent claims 53 and 54 will have been submitted for consideration by the Examiner.

With reference particularly to claim 30, as an example, Applicant's invention is directed to a communication apparatus that is connected to a terminal via a network. The communication apparatus comprises a receiver, a memory, a generator, and a communicator. Additionally, the Applicant's invention includes a controller that, in response to receipt of a designation of management data by the terminal apparatus and response to receipt of a

P17946.A14

command output by the terminal apparatus, controls transmission of the stored e-mail data corresponding to the designated management data to a destination in accordance with the command. The combination of features as recited in, for example claim 30, is not taught, disclosed, nor rendered obvious by the OHTA reference cited by the Examiner even if considered in combination with the MOCHIZUKI reference cited by the Examiner.

In this regard, Applicant notes that the OHTA reference, primarily relied upon by the Examiner, merely teaches a network facsimile apparatus that performs transmitting of image or text information to a client terminal in response to their request (column 20, lines 21-24). Thus, OHTA merely relates to communications and transmission of data between two devices, the network facsimile apparatus and the client terminal. While the relevant image or text information might well be received from a different source, the communications and transmission with which OHTA is concerned relates to a request by the client terminal to the network facsimile apparatus to transfer the image or text information from the network facsimile apparatus to the client terminal.

In this regard, the communication history indices shown in figures 7 and 9 are exactly that. In other words, they represent historical data regarding to where image or text information files have previously been sent. However, the indices do not indicate where such files can be sent in response to a designation of management data by the terminal apparatus and in response to receipt of a command output by the terminal apparatus as explicitly recited

P17946.A14

in Applicant's claims. And that is because, according to the teachings of OHTA, the image or text information is only sent to the client terminal.

In this regard, Applicant notes that OHTA utilizes the destination (i.e., the file number) in transmitting a particular file. However, the utilization of the destination is merely as an identifier and in response to such designation, the identified file is sent to the client terminal, as explicitly set forth in column 19 at line 58.

Accordingly, for each of the above reasons, and certainly for all of the above reasons, the claims in the present application are submitted to be clearly patentable over the references cited by the Examiner. Moreover, as admitted by the Examiner, the secondary reference relied upon by the Examiner does not supply the deficiencies and shortcomings of the primary OHTA reference relied upon. Accordingly, an action on the merits of the present application, including the allowance of all the claims pending herein, is respectfully requested in due course.

Applicant further wishes to make a record of a telephone interview conducted between Applicant's undersigned representative and Examiner Pokrzywa in the present application on January 26, 2004. During the above-noted interview Applicant's representative pointed out the various differences between the disclosure of the reference and the recitations recited in Applicant's claims. At the conclusion of the interview, and after pointing out that OHTA has no capability for sending a file to a destination other than the client terminal, it was

P17946.A14

agreed that the references do not show this feature and that the claims appear to define over the references. However, the Examiner indicated he would, of course, perform an update search upon receipt of Applicant's Response.

Applicant respectfully thanks Examiner Pokrzywa for his cooperation and consideration, both in scheduling the interview and in conducting the interview as well for his constructive remarks regarding Applicant's claims. Applicant looks forward to receiving an Action from the Examiner indicating the allowability of all the claims in the present application.

By the present Response, Applicant's have submitted independent claims 53 and 54 for consideration by the Examiner. These claims are similar to claims 30 and 43, but do not recite the sender information. It is submitted that these claims are patentable at least for the reasons set forth above with respect to claims 30 and 43. Newly submitted dependent claims define the destination as being distinct from the terminal apparatus.

SUMMARY AND CONCLUSION

Applicant has made a clear effort to place the present application in condition for allowance and believe that they have now done so. Applicant has amended the claims and submitted several new claims for consideration.

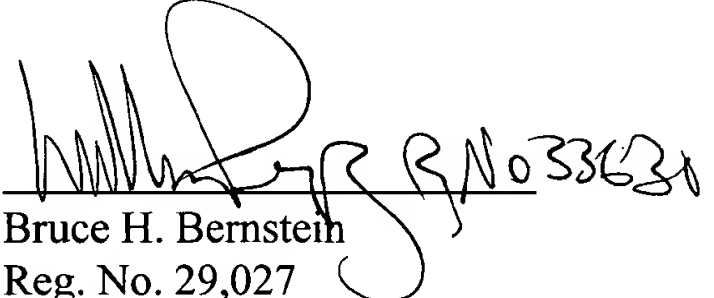
Applicant has discussed the features of the present application and the manner in which it distinguishes over the applied prior art. Applicant has discussed the disclosures of the references cited by the Examiner and has pointed out the substantial and significant shortcomings thereof with respect to Applicant's claims. Applicant has discussed the claim recitations that have pointed out precisely how the recited features are not taught, disclosed nor rendered obvious by the cited references. Applicant has further discussed the newly submitted claims and provided a basis for their patentability. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication to such effect in due course. Moreover, Applicant has made of record a telephone interview conducted in the present application with the prosecuting Examiner.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

P17946.A14

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Junichi IIDA


Bruce H. Bernstein
Reg. No. 29,027

February 6, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191